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10/589,918

08/18/2006

Wah Kiang Yang

MR3483-22

1087

4586 7590 09/28/2007

ROSENBERG, KLEIN & LEE  
3458 ELLICOTT CENTER DRIVE-SUITE 101  
ELLICOTT CITY, MD 21043

EXAMINER

MAI, HUY KIM

ART UNIT

PAPER NUMBER

2873

MAIL DATE

DELIVERY MODE

09/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/589,918

Applicant(s)

YANG ET AL.

Examiner

Huy K. Mai

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17 is/are allowed.
- 6) ☒ Claim(s) 1,2,21-23 and 31 is/are rejected.
- 7) ☒ Claim(s) 3-14,18-20,24-30,32 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 5-7, 10-14, 18-20, 27-30, 32 and 33 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim shall not serve as a basic for any other multiple dependent claims. Any dependent claim that refers to more than one other claim (multiple dependent claim) shall refer to such claim in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 5-7, 10-14, 18-20, 27-30, 32 and 33 have not been further treated on the merits.
2. Claim 2 is objected to because of the following informalities: The applicant should clarify the phrase "in a lower edge of the upper portion" (claim 2, line 2). It appears that the phrase should read --in a lower edge of the lower portion--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by DiChiara et al (6,890,073).

The recited limitations in claims 1, 2 and 30 are shown in DiChiara et al's Figs. 1-6, columns 2-5. Dichiarara et al discloses a spectacle frame 21 comprising a front for holding therein two lenses 14; the front having front end pieces extending rearward at each end thereof, the front end pieces having an upper portion (25, 31) and a lower portion (27, 33); the upper portion having an upper notch 61 and the lower portion having a lower notch 63; a clip (43, 45, 48, 49) for attachment to the front end pieces to releasably retain the end pieces together, the clip comprising an end for engagement in the upper notch 61 and the lower notch 63 for retaining the upper portion 25 and the lower portion together 27.

Regarding claim 2, Dichiarara et al discloses the upper notch 61 is in an upper edge of the upper portion (25, 31), the lower notch 63 is in a lower edge of the lower portion (27, 33); and the end of the clip comprises a bifurcated end terminating in two spaced-apart tabs (43, 45) for engagement in the upper notch 61 and the lower notch 63.

Regarding claim 31, it should be noted that although claim 31 "method claim", the method steps consist of the broad steps of "opening", "inserting", "closing" and "using" etc and therefore these steps would be inherently satisfied by the apparatus of the reference.

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5. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohba (4,978,209).

The recited limitations in claims 21 and 22 are shown in Ohba's Figs. 4 and 5, columns 3 and 4. Ohba discloses a temple 6 for engagement with front end pieces 20 of a spectacle frame, the temple comprising: a temple end 8; a slot extending rearward from the temple end; an upper pin 181 extending upwardly of the temple end; a lower pin 182 extending downwardly of the temple end; the slot being able to be compressed by finger pressure to enable the upper pin and lower pin to engage in pin holes of the front end pieces.

Regarding claim 22, Ohba (Fig.1) discloses a temple end offset portion (between portions 6 and 8) offset inwardly of the temple.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohba in view of McCormick (6,802,604).

Ohba discloses a temple 6 for engagement with front end pieces 20 of a spectacle frame, the temple comprising: a temple end 8; a slot extending rearward from the temple end; an upper pin 181 extending upwardly of the temple end; a lower pin 182 extending downwardly of the temple end; the slot being able to be compressed by finger pressure to enable the upper pin and lower pin to engage in pin holes of the front end pieces. However Ohba does not disclose an integral

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clip. McCormick discloses a temple 3 comprising an integral resilient clip 2 for clipping the eyeglasses on a pocket. It would have been obvious at the time the invention was made to those having ordinary skill in the art in taken the Ohba's spectacle frame in consideration with McCormick's teachings forming an integral clip on the temple for the same purpose of as disclosed by McCormick.

*Allowable Subject Matter*

8. Claims 15-17 are allowed.
9. Claims 3, 4 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claims 8, 9, 25 and 26 are objected to as being dependent upon the above objected claims.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai  
Primary Examiner  
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HKM/

September 25, 2007